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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/622,869	07/18/2003	Suresh K. Tikoo	293102003600	2929
25226	7590	01/26/2006	EXAMINER	
MORRISON & FOERSTER LLP 755 PAGE MILL RD PALO ALTO, CA 94304-1018			CHEN, STACY BROWN	
			ART UNIT	PAPER NUMBER
			1648	

DATE MAILED: 01/26/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/622,869	<b>Applicant(s)</b> TIKOO, SURESH K.	
	<b>Examiner</b> Stacy B. Chen	<b>Art Unit</b> 1648	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-64 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-64 are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1, 2, 4-6, 8, 9, 11-15, 17-39, 56, 57, 59, 60, 62 and 63, drawn to a motif comprising AAATT, classified in class 536, subclass 23.1. In claims 2, 6, 9 and 15, Applicant is required to elect ten sequences from Motif I for search and examination. The elected sequences should be clearly notated and identified by SEQ ID NO.
  - II. Claims 1, 2, 4-6, 8, 9, 11-15, 17-39, 56, 57, 59, 60, 62 and 63, drawn to a motif comprising ATTT, classified in class 536, subclass 23.1. In claims 2, 6, 9 and 15, Applicant is required to elect ten sequences from Motif II for search and examination. The elected sequences should be clearly notated and identified by SEQ ID NO.
  - III. Claims 1, 2, 4-6, 8, 9, 11-15, 17-39, 56, 57, 59, 60, 62 and 63, drawn to a motif comprising TATT, classified in class 536, subclass 23.1. In claims 2, 6, 9 and 15, Applicant is required to elect ten sequences from Motif III for search and examination. The elected sequences should be clearly notated and identified by SEQ ID NO.
  - IV. Claims 1, 2, 4-6, 8, 9, 11-15, 17-39, 56, 57, 59, 60, 62 and 63, drawn to a motif comprising TATTTTTT, classified in class 536, subclass 23.1. In claims 2, 6, 9 and 15, Applicant is required to elect ten sequences from Motif IV for search and

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examination. The elected sequences should be clearly notated and identified by SEQ ID NO.

- V. Claims 1, 2, 4-6, 8, 9, 11-15, 17-39, 56, 57, 59, 60, 62 and 63, drawn to a motif comprising TATATA, classified in class 536, subclass 23.1. In claims 2, 6, 9 and 15, Applicant is required to elect ten sequences from Motif V for search and examination. The elected sequences should be clearly notated and identified by SEQ ID NO.
- VI. Claims 1, 2, 4-6, 8, 9, 11-15, 17-39, 56, 57, 59, 60, 62 and 63, drawn to a motif comprising TTTT, classified in class 536, subclass 23.1. In claims 2, 6, 9 and 15, Applicant is required to elect ten sequences from Motif VI for search and examination. The elected sequences should be clearly notated and identified by SEQ ID NO.
- VII. Claims 1, 3-5, 7, 8, 10-14, 16-39, 56, 57, 59, 60, 62 and 63, drawn to a motif comprising TATTTT, classified in class 536, subclass 23.1. In claims 3, 7, 10 and 16, Applicant is required to elect ten sequences from Motif VII for search and examination. The elected sequences should be clearly notated and identified by SEQ ID NO.
- VIII. Claims 1, 3-5, 7, 8, 10-14, 16-39, 56, 57, 59, 60, 62 and 63, drawn to a motif comprising ATATT, classified in class 536, subclass 23.1. In claims 3, 7, 10 and 16, Applicant is required to elect ten sequences from Motif VIII for search and examination. The elected sequences should be clearly notated and identified by SEQ ID NO.

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- IX. Claims 1, 3-5, 7, 8, 10-14, 16-39, 56, 57, 59, 60, 62 and 63, drawn to a motif comprising TTTA, classified in 536, subclass 23.1. In claims 3, 7, 10 and 16, Applicant is required to elect ten sequences from Motif IX for search and examination. The elected sequences should be clearly notated and identified by SEQ ID NO.
- X. Claims 1, 3-5, 7, 8, 10-14, 16-39, 56, 57, 59, 60, 62 and 63, drawn to a motif comprising AAATTTTA, classified in class 536, subclass 23.1. In claims 3, 7, 10 and 16, Applicant is required to elect ten sequences from Motif X for search and examination. The elected sequences should be clearly notated and identified by SEQ ID NO.
- XI. Claims 1, 3-5, 7, 8, 10-14, 16-39, 56, 57, 59, 60, 62 and 63, drawn to a motif comprising ATTTTT, classified in class 536, subclass 23.1. In claims 3, 7, 10 and 16, Applicant is required to elect ten sequences from Motif XI for search and examination. The elected sequences should be clearly notated and identified by SEQ ID NO.
- XII. Claims 1, 3-5, 7, 8, 10-14, 16-39, 56, 57, 59, 60, 62 and 63, drawn to a motif comprising TATTTATT, classified in class 536, subclass 23.1. In claims 3, 7, 10 and 16, Applicant is required to elect ten sequences from Motif XII for search and examination. The elected sequences should be clearly notated and identified by SEQ ID NO.
- XIII. Claims 40-41, drawn to a method of eliciting an immune response using the compositions of Groups I-XII, classified in class 435, subclass 5.

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- XIV. Claims 42-54, 58, 61 and 64, drawn to a recombinant porcine adenovirus vector comprising a deletion and/or addition of part or all of one or more E1 transcriptional control regions, classified in class 435, subclass 320.1.
- XV. Claims 55, drawn to a method of eliciting an immune response using the composition of Group XIV, classified in class 435, subclass 5.

2. The inventions are distinct, each from the other because of the following reasons:

- a) Groups I-XII are all drawn to distinct nucleotide sequences having different motifs.

Applicant is required to elect of one motif and ten sequences representative of the elected motif.

**This is not a species election.** The resources of the Patent Office are not equipped to search more than ten nucleotide sequences for any given application. A search for all of the possible sequences instantly claimed would be a serious burden.

- b) Groups (I-XII) and XIII are related as product and process of use. Groups XIV and XV are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the nucleotide sequences of Groups (I-XII) and the vectors of Group IX can be used in a materially different method of use, such as probes, or in the case of the adenovirus containing the nucleotide sequence, a detection assay.

- c) Groups (I-XII) and XIV are unrelated inventions. The deletion in the viruses of Group XIV does not correspond to the deletions referred to in Groups I-XII. A search for both sets of

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viruses would be a serious burden because literature pertinent to one Group will not necessarily reveal the other Group.

d) Groups (I-XII) and XV are unrelated inventions, as are Groups XIII and XIV. The viruses of Groups I-XII are not required to practice the method of Group XV. Likewise, the viruses of Group XIV are not required to practice the method of Group XIII.

Because these inventions are distinct for the reasons given above and the literature and sequence search required for one Group is not co-extensive for any other Group, and therefore a serious burden, restriction for examination purposes as indicated is proper. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

3. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP § 821.04. **Process claims that depend from or otherwise include all the limitations of the patentable product** will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1.116; amendments submitted after allowance are governed by 37 CFR 1.312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet

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all criteria for patentability including the requirements of 35 U.S.C. 101, 102, 103, and 112. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of *In re Ochiai*, *In re Brouwer* and 35 U.S.C. § 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. **Failure to do so may result in a loss of the right to rejoinder.** Further, note that the prohibition against double patenting rejections of 35 U.S.C. 121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP § 804.01.

### *Conclusion*

4. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stacy B. Chen whose telephone number is 571-272-0896. The examiner can normally be reached on M-F (7:00-4:30). If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James C. Housel can be reached on 571-272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



Stacy B. Chen  
January 23, 2006